

REMARKS

Claims 1-12 are all the claims pending in the application. Claims 1 and 9 have been amended. Claim 1 has been amended to recite an amount of porosity and claim 9 has been amended to delete the amount of porosity recited.

Entry of the above amendments is respectfully requested.

I. Information Disclosure Statement

With respect to the IDS submitted on December 2, 2003, the Examiner asserts that it fails to comply with 37 C.F.R. §1.98(a)(2), which requires a legible copy of each cited foreign patent document, and the Examiner has crossed out the JP references on the Form PTO/SB/08 A & B (modified).

However, upon review of PAIR, these references were submitted and received by the USPTO on December 2, 2003 (see Foreign References #1-3 dated December 2, 2003). Accordingly, the Examiner is respectfully requested to return a signed and initialed copy of the Form PTO/SB/08 A & B (modified) filed with Applicants' IDS on December 2, 2003, indicating that the listed documents have been considered and made of record.

II. Response to Rejection of Claims 1-9 in view of JP '245

Claims 1-8 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Yuji et al. (JP 2002-110245; hereinafter "JP '245"). In addition, claim 9 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over JP '245.

Applicants respectfully traverse the rejection and submit that JP '245 does not anticipate or render the present invention obvious.

The present invention relates to a crosslinking polymer-supported porous film

comprising a porous film substrate having supported thereon a crosslinking polymer having plural cation-polymerizable functional groups in the molecule. The cation-polymerizable functional group of the crosslinking polymer can be a 3-oxetanyl group and/or an epoxy group (claims 2 and 3). The porosity of the porous film is 20-95%. In addition, the crosslinking polymer may comprise 5-50 % by weight of a radical-polymerizable monomer having a 3-oxetanyl group and/or an epoxy group.

JP '245 discloses a polymer composition comprising an oxetane polymerization monomer, an epoxy polymerization monomer and another radically polymerizable monomer. *See [0013]-[0015].* The oxetane polymerization monomer can be present in an amount of 5-50% and the epoxy polymerization monomer can also be present in an amount of 5-50%.

However, as acknowledged by the Examiner, JP '245 does not disclose the use of a porous film having a specific porosity. This limitation from claim 9 is included into claim 1.

Thus, JP '245 does not anticipate the present invention according to claim 1 as amended.

In addition, JP '245 not teach or suggest the present invention according to claim 1 as amended. Specifically, there is no teaching or suggestion in JP '245 that would motivate one of ordinary skill in the art to use a porous film having the claimed porosity.

The Examiner takes the position that one of ordinary skill in the art would chosen the porosity of the porous film to be 20-95%, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. However, a particular parameter must first be recognized as a result-effective variable before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.

MPEP §2144.05.II.B citing *In re Antonie*, 559 F.2d 618 (C.C.P.A. 1977). Since JP '245 does not disclose a porous film or porosity of a substrate at all, there is no teaching or suggestion that porosity is a result-effective variable. Thus, it would not be obvious to one of ordinary skill in the art to arrive at the claimed porosity of the present invention.

Further, each of claims 2-9 depend directly from claim 1. Thus, it is respectfully submitted that these claims are patentable for at least the same reasons as claim 1.

In view of the above, it is respectfully submitted that JP '245 fails to disclose, teach or suggest the present invention. Accordingly, withdrawal of the rejection is respectfully requested.

III. Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-12 is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account:

Respectfully submitted,



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